

REMARKS

This responds to the Office Action mailed on January 8, 2007.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-24 are now pending in this application.

§102 Rejection of the Claims

Claims 1-24 were rejected under 35 U.S.C. § 102(b) for anticipation by Sacks (U.S. Publication No. 2002/0016765 A1). Applicant respectfully traverses the grounds for rejection for the reasons argued below.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation because Sacks does not disclose each and every element of Applicant’s claims arranged as in the claims.

Claim 1 recites, with emphasis added:

1. A computer-implemented method comprising:

receiving, from a shopping cart application, detailed information concerning one or more items placed by a user in a **virtual shopping cart hosted by a merchant web site, the shopping cart application being external to an online payment service**, the detailed information being sent by the shopping cart application in response to a user request to proceed with a payment for the one or more items; and

upon receiving the detailed information from the shopping cart application, communicating to the user via a communications network one or more user interfaces that facilitate processing of the payment for the one or more items, the one or more user interfaces allowing the user to view content of the virtual shopping cart.

(Emphasis added).

Sacks does not disclose the limitations, “**the shopping cart application being external to an online payment service**” and “**a virtual shopping cart hosted by a merchant web site**,” as recited in claim 1 of the present application.

Referring to Office Actions mailed in 11/30/2005 (page 4, para 1) and 06/13/2006 (page 4, para 2), both of the Office Actions acknowledge that in Sacks, “**it is not fully clear that shopping cart application is external to the payment processor, per se.**”

The present Office Action restates the Office Action mailed 6/3/2005, and disagrees with Applicant’s argument provided 9/8/2005 that Sacks does not disclose the limitation “**the shopping cart application being external to an online payment service.**” The present Office Action states, in page 4, (with emphasis added):

Applicant argues that Sackes does not teach a shopping cart being external to the payment processor. The examiner disagrees and directs the applicants attention to **para 0016-0023**, where the buyer is redirected or transferred to a third party processor. Since the third party payment processor receives a connection from the buyer after the buyer and seller have concluded a transaction and the transaction information is provided through the buyer connection, it is clear that **the third party payment processor is external to the payment processor**.

Applicant disagrees with the assertion of the Office Action that Sacks discloses, “**the third party payment processor is external to the payment processor.**” Referring to para 0016 lines 8-12, Sacks discloses, (with emphasis added):

The third-party payment processor ("payment processor") receives a connection from the buyer and processes the buyer's payment using information provided by the user and/or details of the present transaction received with the buyer's connection.

Clearly, in Sacks, **the third party payment processor is referred to as the payment processor**, i.e., **the third party payment processor is the payment processor**, and vice versa, thus Sacks does not indicate, “**the third party payment processor is external to the payment processor**” as asserted in the present Office Action.

Furthermore, in fact, “**shopping cart**” is not mentioned in para 0016-0023 relied upon by the Office Action. Instead, “**shopping cart**” is disclosed, e.g., in para 0028, 0032, 0034 and 0036, and is claimed in claims 16, 17 and 31 of Sacks, which are reproduced below:

“In another embodiment, **payment processor 106 may provide a third-party shopping cart to track the buyer's purchases**. Thus, in this embodiment, when a buyer's connection is redirected, the buyer may be presented with a shopping cart managed by the payment processor.” (para 0028 of Sacks)

“FIG. 2 is a block diagram of a third-party payment processor according to one embodiment of the invention. In this embodiment, **payment processor 200 comprises communication interface 202, seller interface 204, buyer interface 206, registration module 208, database 210 and payment processing module 212.**” (para 0030 of Sacks)

“**Buyer interface 206 is configured to elicit necessary information from a buyer to create a new account, retrieve an existing account, identify a desired payment mechanism (e.g., credit card, debit card, bank account), access or update a shopping cart, etc.**” (para 0032 of Sacks)

“**Database 210 stores various user information concerning buyers and sellers, such as account information, buyer shopping carts, HTML code for sellers, etc.**” (para 0034 of Sacks)

“In state 300, **a third-party payment processor assists a seller in configuring a link, using HTML or other similar coding, for a buyer to select when he or she wishes to complete a transaction (i.e., initiate payment) or access a third-party shopping cart (e.g., to add or remove an item).**” (para 0036 of Sacks)

“16. The method of claim 1, further comprising **maintaining a shopping cart at the third party for the payor.**”

“17. The method of claim 16, wherein **said shopping cart is configured to track the payor's transactions with multiple payees.**”

“31. **The payment processor of claim 29, further comprising a database configured to store a shopping cart for the payor.**”

Clearly, Sacks does not disclose each and every element of the claimed invention as arranged as in the claim because **the shopping cart of Sacks is a third-party shopping cart and is internal to the third party payment processor**, which is in contrast to claim 1 that recites, “**the shopping cart application being external to an online payment service.**”

Additionally, Sacks does not disclose “**a virtual shopping cart hosted by a merchant web site,**” as recited in claim 1 of the present application, because the shopping cart of Sacks is a third-party shopping cart and is not hosted by a seller (merchant) web site.

Therefore, Applicant respectfully submits that Sacks does not disclose each and every element of claim 1 of the present application, thus Sacks does not anticipate claim 1.

Independent claims 10 and 18 each recite “**the shopping cart application being external to an online payment service**” and “**a virtual shopping cart hosted by a merchant web site.**” For at least the same reasons discussed with respect to claim 1, Sacks does not anticipate claims 10 and 18.

Independent claim 22 recites, “**a virtual shopping cart hosted by a merchant web site**” which, as discussed above, is not disclosed in Sacks. Thus, Applicant submits that Sacks does not disclose every element of claim 22, accordingly Sacks does not anticipate claim 22.

Claims 2-9, 11-17, 19-21, and 23-24 each depend, directly or indirectly, on one of claims 1, 10, 18, or 22. For at least the reasons discussed above for the independent claims 1, 10, 18, and 22, Sacks does not anticipate their respective dependent claims.

Therefore, Applicant respectfully requests the withdrawal and reconsideration of the rejection of claims 1-24.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant’s silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner’s personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of

priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at 612-373-6900 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

3/18/2007

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8 day of March 2007.

Name

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Signature

